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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/802,170

03/17/2004

Kimihiro Kikuchi

9281-4767

3840

7590

02/07/2007

Brinks Hofer Gilson & Lione  
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EXAMINER

LAZORCIK, JASON L

ART UNIT

PAPER NUMBER

1731

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/07/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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**Office Action Summary**

Application No.

10/802,170

Applicant(s)

KIKUCHI, KIMIHIRO

Examiner

Jason L. Lazorcik

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1731

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>03/17/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, Applicant has failed set forth sufficient detail regarding the instant limitation drawn to "a surplus" and its relation to the "volume required for the formation of the optical element". Where in accord with the application disclosure effectively all of the claimed "optical element material" is retained in the product "holder-mounted optical element", Applicant's reference to "a surplus" renders the particular metes and bounds of the instant claim unclear and indefinite.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1-5 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,829,109 B2.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the identified prior art claims set forth the inventive product as a product-by-process whereby the details of the manufacture of the claimed holder-mounted optical element are recited. As presented, the prior art claims set forth sufficient detail regarding the method of manufacture of the optical element that the scope of the claims in the instant application would have been rendered *prima facie* obvious to ordinary skill in the art in view of said prior art.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

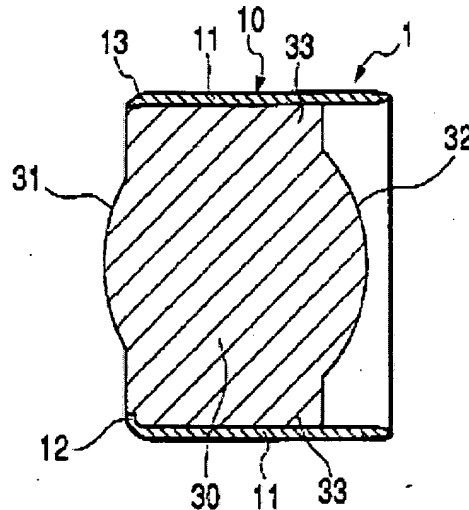
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Otsuki (US 2002/0184919 A1). Basis for the following rejection can be found in the instant

reference paragraphs ¶ [0007]-[0010] and particularly ¶ [0047] – [0056] in addition to figures 1A, 1B, and 4 (see figure 4 excerpt below).

**FIG. 4**



With respect to Claim 1, Otsuki teaches a cylindrical holder material (11) having a thin deformed portion (13) where a side of the holder material is made thin (**Claim 4**) or alternatively where “a thin collar portion is formed on an inner circumferential side of the holder” (**Claim 5**). According to the reference, this cylindrical holder material is disposed in a press forming die, an optical element material (20) is placed inside said holder and thereafter both are heated (¶0053) to a softening temperature of the optical material.

Upon pressing the heated optical material in a pressing mold, the metal ring (10), which is also understood to be in a deformable state or at “a softening temperature”, radially expands due to the pressure generated upon the optical material by the impinging mold elements. The expansion or deformation of the metal ring is here asserted to be implicitly due at least in-part to an excess amount of optical material or “a

surplus" to the volume required for formation of the optical element (**Claim 3**).

Restated, the molding pressures generate an internal force upon this excessive volume of optical material which results in the radial expansion of the metal ring. Otsuki continues indicating that through the pressing operation, the metal ring is adhered strongly to the lens thereby "integrating the optical element inside the holder" (¶0055).

Further, Otsuki explicitly states that during the pressing operation, "the pressure arising from the softened pellet is exerted on the metal ring to expand it...and, the thin-wall portion (13) is deformed easily and the holding portion 15 is deformed easily as a whole" (¶ 0054). The instant disclosure reads directly on Applicants claimed step of deforming the deformed portion (13) of the holder (11) towards the outside thereof by a pressing force applied by the optical material.

Finally, the holder-mounted optical element which results from the Otsuki process is understood to generate "reference surfaces in an optical axis direction (12) and in the radial direction (10) as depicted in figure 4 above (**Claim 2**).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Although not relied upon in the above rejections of claims 1-5, Angenet (US 4,895,585) teaches the manufacture of a holder-mounted optical element(19) which during molding "the ring" or a cylindrical holder material (3) is expanded radially, deforming "the deformed portion of the holder towards the outside thereof by a pressing force", and resulting in an integrated optical element (Abstract,

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and figures 1 A,B, and C). Applicant is advised that any response to the instant Office Action should carefully consider the scope of material disclosed by at least these Angenet reference in addition to the Otsuki reference as set forth above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason L. Lazorcik whose telephone number is (571) 272-2217. The examiner can normally be reached on Monday through Friday 8:30 am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JLL

  
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